

Response to Office Action Dated March 17, 2005

S/N 10/668,091

REMARKS

1
2 In response to the Office Action dated March 17, 2005, Applicants
3 respectfully request reconsideration based on the above claim amendments and the
4 following remarks. Applicants respectfully submit that the claims as presented are
5 in condition for allowance.

6
7 A review of the claims indicates that:

8 Claims 1-20 were originally submitted.

9 Claims 1, 8 and 16 are currently amended.

10
11 Claims 1-2 and 7-12 are rejected under 35 U.S.C. §102(b) as being
12 anticipated by U.S. Patent No. 5,086,674 to Her (hereinafter "Her").

13 Claims 3 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable
14 over Her in view of U.S. Patent No. 4,357,845 to Cornia (hereinafter "Cornia").

15 Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Her
16 in view of U.S. Patent No. 1,463,822 to Ittel (hereinafter "Ittel").

17 Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Her
18 in view of U.S. Patent No. 5,216,940 to Hedden (hereinafter "Hedden").

19 Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Her
20 in view of U.S. Patent No. 4,947,713 to Arnold (hereinafter "Arnold").

21 Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over
22 Her in view of Cornia, and further in view of Ittel.

23 Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over
24 Her in view of Cornia, Ittel and Arnold.

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1 Claims 16-18 are rejected under 35 U.S.C. §103(a) as being unpatentable
2 over U.S. Patent No. 4,620,460 to Gonzales, Jr. (hereinafter "Gonzales, Jr.") in
3 view of Her.

4 Claims 16-19 are rejected under 35 U.S.C. §103(a) as being unpatentable
5 over U.S. Patent No. 4,399,723 to Marleau (hereinafter "Marleau") in view of Her.

6 Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over
7 Marleau in view of Her and Ittel.

8 Claims 8-15 are rejected under 35 U.S.C. §112, second paragraph as being
9 indefinite for failing to particularly point out and distinctly claim the subject
10 matter which Applicant regards as the invention.

11 Claims 1-20 remain in this application.

12 In view of the following remarks, Applicant respectfully requests
13 reconsideration of the rejected claims.

14
15 **35 U.S.C. §112, Second Paragraph**

16 **Claims 8-15**

17 Claims 8-15 are rejected under 35 U.S.C. §112, second paragraph as being
18 indefinite for failing to particularly point out and distinctly claim the subject
19 matter which Applicant regards as the invention. In particular, "the second
20 fastener" recited in claim 8 is cited as lacking antecedent basis. Claim 8 is
21 amended to cure the cited deficiency.

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35 U.S.C. §102Claims 1-2 and 7-12

Claims 1-2 and 7-12 are rejected under 35 U.S.C. §102(b) as being anticipated by Her. Applicant respectfully traverses the rejection.

Amended independent claim 1 recites:

A one piece multi-purpose hand tool, comprising:
a socket body having a socket at a first end;
a key tip; and
an arm portion connected between a second end of the socket body
and the key tip, wherein the arm portion defines an opening to receive a
torque arm device,
wherein the socket body, the key tip, and the arm portion are of one piece,
unitary construction.

Her fails to disclose the one piece multi-purpose hand tool of claim 1. Rather, Her discloses a hand tool having a tubular body 20, with hexical joints 21, 22 formed at both ends. (Her, column 1, lines 51-53). The hex joints 21, 22 may be used to receive a variety of interchangeable connecting blocks 30, 40 having a plurality of hexical-shaped openings to facilitate engagement with various sizes of standard hexical screws in order to fasten or unfasten various sizes of bolts or nuts. (Her, column 1, lines 58-68). Projections 32, 42 on the connecting blocks 30, 40, respectively, mate with holes 24, 24 on the hexical joints 21, 22 allowing the connecting blocks 30, 40 to be attached and removed easily from the the hexical joints 21, 22. (Her, column 1, lines 59-64). Her also discloses a variety of interchangeable bits 50, 60, 70, which may be detachably attached to hexical holes 33, 43 in the connecting blocks 30, 40. (Her, column 2, lines 1-18).

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Thus, in order to use a bit 50, 60, 70 with the hand tool disclosed in Her, a connecting block 30, 40 must first be attached to the tubular body 20. Then the user must subsequently attach a bit 50, 60, 70 to the connecting block 30, 40. As a result three separate components must be combined by a user before the functionality of one of those components -- the bit 50, 60, 70 -- can be exploited. In this manner, Her effectively represents the very prior art that Applicant sought to overcome -- an unwieldy combination of tool components. This is markedly different than "the socket body, the key tip, and the arm portion are of one piece, unitary construction" as recited in claim 1.

Her also discloses an opening 25 formed in the body 20 into which a spoon shaped member 80 may be inserted. (Her, column 2, lines 24-32). The sole disclosed purpose of member 80 is the adjustment of spokes on a bicycle through use of a connecting slot 82 which functions as a "stop". Her fails to disclose or make any mention of the member 80 being a torque arm, or being used to generate torque. In fact, Her's disclosure is inconsistent with such a notion. This can be seen with reference to the plurality of hexical shape openings formed in the connecting blocks 30, 40 as disclosed by Her. (Her, column 1, lines 64-67). If spoon shaped member 80 were to be used to apply torque about a longitudinal axis of the body 20, such an action would be useless in utilizing the hexical shape openings to fasten or unfasten bolts or nuts. Instead, the only plausible result would be the stripping of the hexical shape openings, or the bolts or nuts. As a result, Her not only fails to disclose "the arm portion defines an opening to receive a torque arm device" as recited in claim 1, but Her also teaches away from using the opening 25 for any torque-related functionality.

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1 The Office argues that the claimed hand tool is shown in elements 40, 20,
2 51 and 25 (found in Figs. 1-6). (Office Action, Page 2). Applicant respectfully
3 disagrees. As noted above, Her does not disclose "the socket body, the key tip,
4 and the arm portion are of one piece, unitary construction". Rather, the hand tool
5 disclosed in Her includes many different components which may be detachably
6 attached to the body 20, or to the connecting blocks 30, 40 -- which are themselves
7 attached to the body 20. Thus the hand tool in Her is nonunitary and requires the
8 assembly of several pieces.

9 Moreover, the elements cited by the Office fail to include "an arm portion
10 connected between a second end of the socket body and the key tip, wherein the
11 arm portion defines an opening to receive a torque arm device". Rather, the
12 elements cited by the Office consist only of an opening 25 formed in the body 20
13 into which a connecting slot 82 on a spoon shaped member 80 may be inserted
14 such that the slot 82 may be used to function as a "stop" to facilitate the operation
15 of adjusting the spokes of a bicycle. The opening 25 is not used for any torque-
16 related functionality, and indeed, is ill-suited for such functionality.

17 For these reasons, claim 1 is allowable over Her. Applicant respectfully
18 requests that the §102(b) rejection be withdrawn.

19 Dependent claims 2 and 7 are allowable at the least by virtue of their
20 dependency on base claim 1, as well as for the additional elements they contain.
21 Applicant respectfully requests that the §102(b) rejection of claims 2 and 7 be
22 withdrawn.
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Amended independent claim 8 recites:

A one piece multi-purpose hand tool, comprising:
means for torquing a first female fastener;
means for socket wrenching a second fastener; and
an arm portion connected between the means for torquing and the
means for socket wrenching, wherein the arm portion defines an opening to
receive a torque arm device,
wherein the means for torquing, the means for socket wrenching,
and the arm portion are of one piece, unitary construction.

Her fails to disclose the one piece multi-purpose hand tool of claim 8. As discussed above in conjunction with claim 1, Her discloses attaching a connecting block 30, 40 to the tubular body 20, then attaching a bit 50, 60, 70 to the connecting block 30, 40. Under Her, three separate components must be combined by a user before the functionality of one of those components – the bit 50, 60, 70 – can be exploited. In contrast, no such assembly is needed in order to use the hand tool recited in claim 8. This results because the hand tool in claim 8 recites that “the means for torquing, the means for socket wrenching, and the arm portion are of one piece, unitary construction”.

Moreover, Her also fails to disclose “an arm portion connected between the means for torquing and the means for socket wrenching, wherein the arm portion defines an opening to receive a torque arm device”. Instead, Her discloses an opening 25 formed in the body 20 into which a spoon shaped member 80 having a connecting slot 82 may be inserted, with the slot 82 functioning as a “stop” to facilitate the operation of adjusting the spokes of a bicycle. If, for the sake of argument, the spoon shaped member 80 was used to apply a torque to the longitudinal axis of the body 20, the result would be the deleterious stripping of

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1 the hexical shape openings, or the bolts or nuts with which the hexical shaped
2 openings might be engaged.

3 The Office relies on the same grounds to reject claim 8 as noted above in
4 conjunction with claim 1, namely elements 40, 20, 51 and 25 (found in Figs. 1-6).
5 (Office Action, Page 2). Applicant respectfully disagrees. As noted above, Her
6 does not disclose "the means for torquing, the means for socket wrenching, and
7 the arm portion are of one piece, unitary construction". Rather, the hand tool
8 disclosed in Her includes many different components which must be detachably
9 attached to the body 20, or to the connecting blocks 30, 40 which themselves must
10 be attached to the body 20. Thus the hand tool in Her is nonunitary and requires
11 the assembly of several pieces.

12 Moreover, the elements cited by the Office also fail to include "an arm
13 portion connected between the means for torquing and the means for socket
14 wrenching, wherein the arm portion defines an opening to receive a torque arm
15 device". Rather, the elements cited by the Office consist only of an opening 25
16 formed in the body 20 into which a connecting slot 82 on a spoon shaped member
17 80 may be inserted such that the slot 82 may be used as a "stop" to facilitate the
18 operation of adjusting the spokes of a bicycle. The opening 25 disclosed in Her is
19 not used for any torque-related functionality, and indeed, would be ill-suited for
20 such functionality.

21 For these reasons, claim 8 is allowable over Her. Applicant respectfully
22 requests that the §102(b) rejection be withdrawn.

23 Dependent claims 9-12 are allowable at the least by virtue of their
24 dependency on base claim 1, as well as for the additional elements they contain.

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1 Applicant respectfully requests that the §102(b) rejection of claims 9-12 be
2 withdrawn.

3
4 35 U.S.C. §103

5 The remaining claims are rejected under a set of §103 rejections, all of which
6 rely on Her in conjunction with other references. Most of the claims depend from
7 base claims 1 and 8 addressed above. Claim 16 is independent and will be discussed
8 in more detail below.

9
10 Her + Cornia

11 Claims 3 and 13 stand rejected under 35 U.S.C. §103(a) as being
12 unpatentable over Her in view of Cornia. Applicant respectfully traverses the
13 rejection.

14 Claims 3 and 13 depend from respective independent claims 1 and 8. As
15 such, they include the features recited in these base claims. The combination of
16 Her and Cornia fails to teach or suggest the features of these base claims from
17 which the cited claims depend. Her is primarily cited as teaching the base
18 features, and Cornia is cited as teaching a notch in a key tip. (Office Action, Page
19 2).

20 With respect to dependant claim 3, neither reference discloses "the socket
21 body, the key tip, and the arm portion are of one piece, unitary construction" as
22 required by claim 1 from which claim 3 depends. Her specifically teaches a
23 nonunitary hand tool which requires the assembly of several pieces. For example,
24 under Her, three separate components must be combined by a user before the
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1 functionality of one of those components – the bit 50, 60, 70 -- can be exploited.
2 Essentially Her represents the very prior art that Applicant sought to overcome.
3 Cornia offers no missing teaching.

4 In addition, neither reference discloses “an arm portion connected between
5 a second end of the socket body and the key tip, wherein the arm portion defines
6 an opening to receive a torque arm device” as required by claim 1 from which
7 claim 3 depends. Her specifically teaches an opening 25 formed in the body 20
8 into which a spoon shaped member 80 may be inserted, with the sole disclosed
9 purpose of member 80 being the adjustment of spokes on a bicycle through use of
10 a connecting slot 82 which functions as a “stop”. Her does not teach using the
11 opening 25 to receive a torque arm device, and indeed, the opening 25 is ill-suited
12 for such a use.

13 Cornia offers no missing teaching. Accordingly, the combination of Her
14 and Cornia fails to teach or suggest the tool of claim 3. Applicant respectfully
15 requests that the §103 rejection of claim 3 be withdrawn.

16 With respect to dependant claim 13, neither Her nor Cornia discloses “the
17 means for torquing, the means for socket wrenching, and the arm portion are of
18 one piece, unitary construction” as required by claim 8 from which claim 13
19 depends. Her specifically teaches a nonunitary hand tool which requires the
20 assembly of several pieces. For example, under Her, three separate components
21 must be combined by a user before the functionality of one of those components –
22 the bit 50, 60, 70 -- can be exploited. Essentially Her represents the very prior art
23 that Applicant sought to overcome. Cornia offers no missing teaching.

24

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1 In addition, neither reference discloses "an arm portion connected between
2 the means for torquing and the means for socket wrenching, wherein the arm
3 portion defines an opening to receive a torque arm device" as required by claim 8
4 from which claim 13 depends. Her specifically teaches an opening 25 formed in
5 the body 20 into which a spoon shaped member 80 may be inserted, with the sole
6 disclosed purpose of member 80 being the adjustment of spokes on a bicycle
7 through use of a connecting slot 82 which functions as a "stop". Her fails to
8 disclose or make any mention of the member 80 being a torque arm, or being used
9 to generate torque. Nor does Her teach using the opening 25 to receive a torque
10 arm device. Indeed, the opening 25 is ill-suited for such a use.

11 Cornia offers no missing teaching. Accordingly, the combination of Her
12 and Cornia fails to teach or suggest the tool of claim 13. Applicant respectfully
13 requests that the §103 rejection of claim 13 be withdrawn.

14
15 Her + Ittel

16 Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable
17 over Her in view of Ittel. Applicant respectfully traverses the rejection.

18 Intel is cited as teaching an opening extending partially through an arm for
19 receiving a torque member. (Office Action, page 3).

20 Ittel and Her, alone or in combination, neither teach nor disclose "the
21 socket body, the key tip, and the arm portion are of one piece, unitary
22 construction" as recited in claim 1 from which claim 4 depends. Rather both Ittel
23 and Her teach tools which must be assembled from several parts, in effect
24 representing the same prior art which Applicant sought to overcome.
25

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Moreover, Ittel teaches away from a combination with Her. According to the teachings of Ittel, arm 4 is used to apply a torque about a longitudinal axis of a head 1 which is formed with a socket 2 to receive a nut or bolt. (Ittel, line 39-70, and Figs. 1 and 2). If such a torque were applied by the spoon shaped member 80 in Her, the body 20 would have torque applied about its longitudinal axis. Such an action would not only be useless in utilizing the hexical shape openings to fasten or unfasten bolts or nuts, but would result in the deleterious stripping of the hexical shape openings and/or the bolts or nuts being engaged by the hexical shape openings. Thus the combination Her and Ittel fails to disclose, teach or suggest "an arm portion connected between a second end of the socket body and the key tip, wherein the arm portion defines an opening to receive a torque arm device".

Accordingly, the combination of Her and Ittel fails to teach or suggest the tool of claim 4. Applicant respectfully requests that the §103 rejection of claim 4 be withdrawn.

Her + Hedden

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Her in view of Hedden. Applicant respectfully traverses the rejection.

Hedden is cited as teaching a socket wrench tool being formed of metal. (Office Action, page 3). Hedden provides no teaching regarding "the socket body, the key tip, and the arm portion are of one piece, unitary construction" as recited by claim 1 from which claim 5 depends. As noted above, Her teaches tools which must be assembled from several parts, in effect representing the same prior art

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1 which Applicant sought to overcome. Hedden fails to add any relevant teaching
2 with respect to this feature.

3 Moreover, the combination of Her and Hedden fails to teach or suggest, "an
4 arm portion connected between a second end of the socket body and the key tip,
5 wherein the arm portion defines an opening to receive a torque arm device". As
6 noted above, Her fails to disclose or make any mention of the opening 25 being
7 useful to receive a torque arm device. Rather, the orientation of the hexical
8 openings relative to the opening 25, render the opening 25 useless for such an
9 application. Hedden fails to add any relevant teaching with respect to this feature.

10 Accordingly, the combination of Her and Hedden fails to teach or suggest
11 the tool of claim 5. Applicant respectfully requests that the §103 rejection of
12 claim 5 be withdrawn.

13
14 Her+Arnold

15 Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable
16 over Her in view of Arnold. Applicant respectfully traverses the rejection.

17 Arnold is cited as teaching a plastic sheath around a socket. (Office Action,
18 page 3). Arnold provides no teaching regarding "the socket body, the key tip, and
19 the arm portion are of one piece, unitary construction" as recited by claim 1 from
20 which claim 6 depends. As noted above, Her teaches tools which must be
21 assembled from several parts, in effect representing the same prior art which
22 Applicant sought to overcome. Arnold fails to add any relevant teaching with
23 respect to this feature.

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Moreover, the combination of Her and Arnold fails to teach or suggest, "an arm portion connected between a second end of the socket body and the key tip, wherein the arm portion defines an opening to receive a torque arm device". As noted above, Her fails to disclose or make any mention of a torque arm being used to generate torque. In addition, the orientation of the hexical openings relative to the opening 25, render the opening 25 useless for such an application. Arnold fails to add any relevant teaching with respect to this feature.

Accordingly, the combination of Her and Arnold fails to teach or suggest the tool of claim 6. Applicant respectfully requests that the §103 rejection of claim 6 be withdrawn.

Her + Cornia + Ittel

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Her in view of Cornia (as applied above), and further in view of Ittel. Applicant respectfully traverses the rejection.

Claim 14 depends from claim 8, and hence requires that "the means for torquing, the means for socket wrenching, and the arm portion are of one piece, unitary construction". As discussed above, Her, Cornia, and Ittel, taken alone or in combination, fail to teach such an element. Moreover, as also discussed above, Her, Cornia, and Ittel, taken alone or in combination, also fail to teach "an arm portion connected between the means for torquing and the means for socket wrenching, wherein the arm portion defines an opening to receive a torque arm device" as required by claim 8 from which claim 14 depends. For these reasons, claim 14 should be allowed.

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Her + Cornia + Ittel + Arnold

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Her in view of Cornia and Ittel (as applied above), and further in view of Arnold. Applicant respectfully traverses the rejection.

Claim 15 depends from claim 8, and hence requires that "the means for torquing, the means for socket wrenching, and the arm portion are of one piece, unitary construction". As discussed above, Her, Cornia, Ittel, and Arnold, taken alone or in combination, fail to teach such an element. Moreover, as also discussed above, Her, Cornia, Ittel, and Arnold, taken alone or in combination, also fail to teach "an arm portion connected between the means for torquing and the means for socket wrenching, wherein the arm portion defines an opening to receive a torque arm device" as required by claim 8 from which claim 14 depends.

In addition, by requiring a combination of 4 different references, the Office creates the very scenario which Applicant sought to overcome an unwieldy combination of tools which weighs more and takes up more space than the hand tool recited in claim 15.

For these reasons, claim 15 should be allowed.

Gonzales, Jr. + Her

Claim 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gonzales, Jr. in view of Her. Applicant respectfully traverses the rejection.

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Amended independent claim 16 recites:

A set of tools, comprising:
a first tool including a first socket body having a first socket, a first key tip, and a first arm portion connected between the first socket body and the first key tip, wherein the first arm portion includes a torque arm opening to receive a torque arm device; and
a second tool including a second socket body having a second socket, a second key tip, and a second arm portion connected between the second socket body and the second key tip,
wherein the second tool is removably nested within the first tool, and further wherein the torque arm opening of the first arm portion remains accessible to receive the torque arm device.

Gonzales, Jr. and Her, alone or in combination, do not disclose, teach or suggest the elements of claim 16.

The Office cites Gonzales, Jr. as teaching first and second interconnected socket bodies 12, sockets 13, arms 16, and key tips 14. (Office Action, page 4). The Office argues that it would have been obvious to combine these elements with the socket body 40, arm 20, key tip 51 and opening 25 as taught by Her to arrive at the hand tools recited in claims 16-19. Applicant respectfully disagrees.

As discussed above, Her fails to disclose, teach or suggest "a first arm portion connected between the first socket body and the first key tip, wherein the first arm portion includes a torque arm opening to receive a torque arm device". Instead, Her discloses an opening 25 formed in the body 20 into which a spoon shaped member 80 having a connecting slot 82 may be inserted, with the slot 82 functioning as a "stop" to facilitate the operation of adjusting the spokes of a bicycle. The spoon shaped member 80 is not a torque member, and the opening 25 is ill-suited to receive a torque arm device. In fact, were the opening 25 to be

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1 used to receive a torque arm device applying torque to the longitudinal axis of the
2 body 20, the result would be the deleterious stripping of the hexical shape
3 openings, or the bolts or nuts with which the hexical shaped openings might be
4 engaged. Gonzales, Jr. offers no missing teaching.

5 According to Gonzales Jr., single socket members 12 may be
6 interconnected such that a middle section 16 of each socket member 10 may be
7 interfit into a next larger adjacent sized socket member 10, with a shank end 14 of
8 each socket member 10 being fit into an inset 18 of the adjacent socket member.
9 (Gonzales, Jr., column 1 line 65-col.2 line 4, see also Fig. 4).

10 No motivation is provided as to how a torque arm opening could be formed
11 in the apparatus disclosed in Gonzales, Jr. in a manner consistent with Her.
12 Rather, Gonzales, Jr. teaches away from such a combination with Her since the
13 socket members 12 in Gonzales, Jr. overlap to such an extent that if an opening
14 existed through the body of a socket member, once interlocked with another
15 socket member, the opening would be blocked by the interconnected socket
16 member, thus precluding the insertion of a torque arm. As such, Gonzales, Jr. and
17 Her either alone, or in combination, fail to disclose, show, teach or suggest "the
18 torque arm opening of the first arm portion remains accessible to receive the
19 torque arm device".

20 Accordingly, the combination of Gonzales, Jr. and Her fails to teach or
21 suggest the set of tools of claim 16. Applicant respectfully requests that the §103
22 rejection of claim 16 be withdrawn. If the rejection is maintained, Applicant
23 respectfully requests that the Office provide more description as to how the
24 teachings of Her and Gonzales, Jr. may be combined.

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1 **Dependant claims 17-18** depend from base claim 16 and are allowable by
2 virtue of this dependency as well as for the additional elements they contain.
3 Applicant respectfully requests that the §103 rejection of claims 17 and 18 be
4 withdrawn.

5
6 **Marleau+Her.**

7 **Claim 16-19** stand rejected under 35 U.S.C. §103(a) as being unpatentable
8 over Marleau in view of Her. Applicant respectfully traverses the rejection.

9
10 **Amended independent claim 16** recites:

11 A set of tools, comprising:
12 a first tool including a first socket body having a first socket, a first
13 key tip, and a first arm portion connected between the first socket body and
14 the first key tip, wherein the first arm portion includes a torque arm opening
15 to receive a torque arm device; and
16 a second tool including a second socket body having a second
17 socket, a second key tip, and a second arm portion connected between the
18 second socket body and the second key tip,
19 wherein the second tool is removably nested within the first tool, and
20 further wherein the torque arm opening of the first arm portion remains
21 accessible to receive the torque arm device.

22 Marleau and Her, alone or in combination, do not disclose, teach or suggest
23 the elements of claim 16.

24 Marleau is cited as teaching all of the claimed subject matter of claims 16-
25 19 except for a torque opening in an arm. (Office Action, page 4). The Office
26 concedes that Marleau only teaches a torque opening in the socket body. (Office
27 Action, page 4). Despite this, the Office asserts and that it would have been

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1 obvious to one having ordinary skill in the art to combine the teachings of Marleau
2 with those of Her to arrive at an opening in an arm. (Office Action, page 4).

3 In citing Marleau, the Office omits identifying the specific elements of
4 Marleau that correspond to the elements of claim 16, so Applicant in a good faith
5 effort to respond to the Office Action identifies the elements of Marleau that
6 Applicant believes the Office intended to apply in the rejection.

7 Marleau discloses in Figs. 1-4 a number of tool segments having: a wrench
8 socket 14 (which Applicant assumes the Office argues is equivalent to a socket
9 body); a head 12 (which Applicant assumes the Office argues is equivalent to a
10 key tip); a shank 10 (which Applicant assumes the Office argues is equivalent to
11 an arm portion) and a hexagonal bore 18 in the socket 14 (which Applicant
12 assumes the Office argues is equivalent to an opening to receive a torque arm
13 device).

14 As conceded by the Office, Marleau does not disclose any openings in the
15 shank 10. Therefore, Marleau does not teach "the first arm portion includes a
16 torque arm opening to receive a torque arm device" as recited in Claim 16.
17 Rather, as disclosed at col. 2, lines 21-28, Marleau discloses engaging the shank
18 10 of another tool segment within the bore 18 (in socket 14) to provide rotational
19 leverage. Clearly, it would not be possible to form bore 18 in shank 10 as they
20 have roughly the same width.

21 Her fails to add any relevant teaching with respect to this feature. The
22 Office cites Her as teaching an opening 25 in an arm 20 to receive a torque arm
23 80. (Office Action, page 5). However, as discussed above, Her fails to disclose,
24 teach or suggest "a first arm portion connected between the first socket body and
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1 the first key tip, wherein the first arm portion includes a torque arm opening to
2 receive a torque arm device". Instead, Her discloses an opening 25 formed in the
3 body 20 into which a spoon shaped member 80 having a connecting slot 82 may
4 be inserted, with the slot 82 functioning as a "stop" to facilitate the operation of
5 adjusting the spokes of a bicycle. Opening 25 is not configured to receive a torque
6 arm device. In fact, were opening 25 to be used to receive such an arm, and if the
7 arm were to be used to apply a torque to the longitudinal axis of the body 20, the
8 result would be the deleterious stripping of the hexical shaped openings, or the bolts
9 or nuts with which the hexical shaped openings might be engaged.

10 Moreover, Marleau teaches away from combining its teachings with those
11 of Her. This arises because the bore 18 taught by Marleau has roughly the same
12 width as the shank 10. As a result, the shank 10 is too small to operatively have a
13 bore 18 running through it, and thus placing an opening 25 as taught by Her into
14 the shank 10 would make no operative sense.

15 Thus, since Her provides no teaching of a torque arm opening, and since
16 Marleau teaches away from including a such an opening in the shank 10, Marleau
17 and Her, taken alone or in combination, fail to disclose, teach, or suggest "a first
18 arm portion connected between the first socket body and the first key tip, wherein
19 the first arm portion includes a torque arm opening to receive a torque arm
20 device".

21 Accordingly, the combination of Marleau and Her fails to teach or suggest
22 the set of tools of claim 16. Applicant respectfully requests that the §103 rejection
23 of claim 16 be withdrawn
24
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1 Dependant claims 17-19 depend from base claim 16 and are allowable by
2 virtue of this dependency as well as for the additional elements they contain.
3 Applicant respectfully requests that the §103 rejection of claims 17-19 be
4 withdrawn.

5
6 Marleau + Her + Ittel

7 Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable
8 over Marleau in view of Her (as applied above) and further in view of Ittel.
9 Applicant respectfully traverses the rejection.

10 Claim 20 depends from claim 16, and hence requires "a first arm portion
11 connected between the first socket body and the first key tip, wherein the first arm
12 portion includes a torque arm opening to receive a torque arm device". As
13 discussed above Her and Marleau, taken alone or in combination, fail to teach
14 such an element, and in fact, Marleau teaches away from combination with Her.

15 Ittel offers no missing teachings. The Office cites Ittel as disclosing an
16 opening extending partially through an arm to receive a torque member, however,
17 as discussed above Ittel teaches away from a combination with Her. According to
18 Ittel, arm 4 is used to apply a torque about a longitudinal axis of a head 1 which is
19 formed with a socket 2 to receive a nut or bolt. If such a torque were applied by
20 the spoon shaped member 80 in Her, the body 20 would have torque applied about
21 its longitudinal axis. Such an action would not only be useless in utilizing the
22 hexical shape openings to fasten or unfasten bolts or nuts, but would result in the
23 deleterious stripping of the hexical shape openings and/or the bolts or nuts being
24 engaged by the hexical shape openings.

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1 Thus, since the combination Marleau, Her and Ittel fails to disclose, teach
2 or suggest "a first arm portion connected between the first socket body and the
3 first key tip, wherein the first arm portion includes a torque arm opening to receive
4 a torque arm device", and since Her teaches away from a combination with
5 Marleau, and Ittel teaches away from a combination with Her, claim 20 should be
6 allowed.

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Conclusion

The Applicant submits that all of the remaining claims are in condition for allowance and respectfully requests that a Notice of Allowability be issued. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests that the undersigned attorney be contacted for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: July 18, 2005

By: Jim Patterson

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